

Docket No.: 223002099600
223002099601
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent and Patent Application of:
Vincenzo SCARLATO et al.

Patent No.: 6,914,131

Art Unit: 1631

Issued: July 5, 2005

Examiner: Shubo ZHOU

Patent Ser. No.: 10/864,684 (continuation of above)

Art Unit: 1645

Filed : June 8, 2004

Examiner: P. Baskar

For: NEISSERIAL ANTIGENSI

**VERIFIED STATEMENT IN SUPPORT OF PETITION FOR RETROACTIVE FOREIGN
FILING LICENSE PURSUANT TO 37 C.F.R. §5.25**

I, Alisa HARBIN, declare as follows:

1. I am submitting this statement in support of the Petition for Retroactive Foreign Filing License for:

- GB App. No. 9723516.2, filed Nov. 6, 1997;
- GB App. No. 9724190.5, filed Nov. 14, 1997;
- GB App. No. 9724386.9, filed Nov. 18, 1997;
- GB App. No. 9725158.1, filed Nov. 27, 1997;
- GB App. No. 9726147.3, filed Dec. 10, 1997;
- GB App. No. 9800759.4, filed Jan. 14, 1998;
- GB App. No. 9819016.8, filed Sept. 1, 1998; and
- PCT App. No. PCT/IB98/001665, filed Oct. 9, 1998 (collectively, the “**GB Priority and PCT Applications**”).

In addition, to the extent that the foreign filing license granted for the subject matter of U.S. Ser. No. 09/303,518 granted June 9, 1999 is ineffective for the following later filed foreign patent applications and patents, this statement additionally in support of the Petition for Retroactive Foreign Filing License for:

- BR App. No. PI9813930-4, filed May 4, 2000;
- CA App. No. 2308606, filed May 4, 2000;
- CN Pat. No. CN1263854, filed June 30, 2000;
- EP App. No. 98946675.0 (issued as EP1029052), filed April 28, 2000 (together with national patents issuing therefrom);
- HK App. No. 00105869.7, filed Sept. 19, 2000;
- JP App. No. 2000-520572, filed May 2, 2000;
- MX App. No. PA/a/00/004363, filed May 4, 2000;
- RU App. No. 2000114245 (issued as RU Pat. No. RU223291), filed June 5, 2000;
and
- SG App. No. SG72388, filed April 18, 2000 (collectively, the **“National Phase Foreign Patent Applications”**).
- BR Div. No. PI9816251-9, filed July 31, 2007;
- CN Div. No. 200510113395.7, filed Oct. 17, 2005;
- EP Div. No. 07075379.3 (published as EP1900818), filed May 21, 2007;
- CA Div. No. 2,671,261, filed May 14, 2009;
- HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed June 6, 2001;
- JP Div. No. 2005-290551, filed Oct. 3, 2005;
- MX Div. No. MX/a/2009/000817, filed Jan. 21, 2009; and
- RU Div. No. 2004100847, filed Jan. 8, 2004 (collectively, the **“Foreign Divisional Patent Applications”**)

2. I was assigned responsibility for managing the prosecution of the patent family that includes the above patent and patent application for at least the following two periods: from mid-January 1998 through 2004 and from approximately February 2006 through June 2006.

3. The law firm that was selected to draft and file the GB Priority and PCT Applications was Carpmaels and Ransford, which is a United Kingdom firm of patent attorneys. Being located in the United Kingdom allowed for greater interaction between the inventors who were all located in Siena, Italy, and the individuals drafting the patent applications given that the time difference is only one hour.

4. From early to mid-1998 through the filing of the PCT patent application, I was working with Huw Hallybone and Cameron Marshall, European patent attorneys at Carpmaels and Ransford, in preparing and filing certain of the GB Priority and PCT Applications. The information upon which the above patent and patent application were based was provided directly to Carpmaels and Ransford, though in certain instances I was cc'd on the communications, by researchers from Chiron SpA facility in Siena, Italy. The inventors with whom we had interacted regarding the preparation of the one of the seven GB priority applications with which I was involved included Rino Rappuoli, Vega Massignani, and Vincenzo Scarlato, who were all Italian citizens living in Italy and working at Chiron SpA's facility in Siena, Italy. When preparing the PCT application for filing, we confirmed that all of the inventors were Italian citizens living in Italy. I had no knowledge of, or reason to believe that, any of the work upon which the any of the GB Priority and PCT Applications or the above patent and patent application were based was performed in the United States when I reviewed, and eventually approved for filing, the draft patent applications for foreign filing including one of the seven GB priority applications on Sept. 1, 1998, respectively, or the PCT patent application filed on Oct. 9, 1998. Thus, the preceding patent applications were foreign filed through error and without deceptive intent without previously obtaining a foreign filing license from the USPTO.

5. During the ordinary course of prosecution through 2004 and again from approximately February 2006 through June 2006, I instructed various foreign associates to file foreign divisional patent applications. It was not Chiron Corporation's policy, and is not Novartis Vaccines and Diagnostic, Inc.'s policy, to review the patent family to determine whether a foreign filing license in the US was required and, if so, whether a foreign filing license was obtained when filing a foreign divisional application. Furthermore as discussed above, I had no knowledge of, or reason to believe that, any of the work that was included in the GB Priority and PCT Applications or upon which the above patent and patent application were based was performed in the United States when I instructed the foreign associates to file the following foreign divisional patent applications based upon the PCT patent application: HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed June 6, 2001; RU Div. No. 2004100847, filed Jan. 8, 2004. Furthermore, even when I was not directly responsible for managing the prosecution of the patent family that includes the above patent and patent application between 2004 and February 2006, the patent attorneys who were responsible reported to me and depended upon my knowledge of the prosecution of this patent family when deciding when and where to file other Foreign Divisional Patent Applications filed during that time. Thus, if the foreign filing license previously granted for U.S. Ser. No. 09/303,518 is ineffective for any of the foreign divisional patent applications, I was not aware that a foreign filing license might be required for the United States for the filing of any of the foreign divisional patent applications or that an effective foreign filing license had not been obtained from the USPTO, and therefore the preceding divisional patent applications were foreign filed through error and without deceptive intent without previously obtaining a foreign filing license from the USPTO.

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6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent and patent application or any patent issued thereon.

10.11.09 Alisa Harbin
Date Name: Alisa HARBIN